

**REMARKS**

Claims 1-6 and 8-24 are pending in this Application. Claims 1, 10, 11 and 21 are independent claims. Claims 10, 11, 19, 20 and 23 stand withdrawn. By this Amendment, claim 7 is cancelled without prejudice or disclaimer and claims 1, 8 and 9 are amended. No new matter is added.

**Priority Document**

Applicant requests that the Examiner acknowledge receipt of the certified copy of the priority document (NL 1021913) a copy of which may be viewed on the USPTO PAIR web site.

**Restriction Requirement**

The Examiner has imposed a Restriction Requirement/Election of Species and requested that the Applicant elects one of the following two identified groups of claims for prosecution in the present application. The groups are as follows:

Group I, claims 1-10 and 12-18, drawn to a filter; or

Group II, claims 11, 19 and 20, drawn to a method of assembly of the filter.

In response to the Restriction Requirement, Applicant elected to prosecute Group I, including claims 1-10 and 12-18. The Examiner further alleged that the present application contains claims directed to more than one species. Specifically, the Examiner alleged that separate species are shown in Figs. 4A, 5A, 6A, 7A, 8B, 9A, 9B, 9C and 12.

In response to the Election of Species Requirement, Applicant elected the species represented by Fig. 4A, readable on claims 1-9 and 12-18, as well as new

claims 21, 22 and 24. Applicant reminds the Examiner that claims 1-3, 5-7, 10, 11, 13 and 21 are generic to at least the species represented by Figs. 4A, 5A, 6A, 7A, 8B, 9A, 9B and 9C. Therefore, upon allowance of a generic claims, rejoinder and allowance of claims drawn on the remaining non-elected species is requested.

As pointed out above, in restricting the claims, the Examiner required restriction between product and process claims. However, as previously pointed out to the Examiner, the present application is a national stage of a PCT application submitted under 35 U.S.C. §371 and therefore unity of invention rules apply. According to the rules of unity of invention, an international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to one of the following combinations of categories:

- 1- a product and a process specially adapted for the manufacture of the product; or
- 2- a product and process for use of the product; or
- 3- a product, a process specially adapted for the manufacture of the product and the use of the product; or
- 4- a process and an apparatus or means specially designed for carrying out the process; or
- 5- a product, a process specially adapted for the manufacture of the product, and an apparatus or means specifically designed for carrying out the process.

As the alleged groups of claims relate to at least one of the aforementioned

categories, specifically defined as having unity of invention, the restriction of the claims is incorrect and must be withdrawn (see 37 C.F.R. §1.475(b)).

Moreover, the Examiner alleged there is no unity of invention because “the filter as claimed is anticipated by several references cited in the PCT search report.” However, as previously pointed out to the Examiner, none of the references cited in the PCT search report discloses or suggests the concept of arranging the membrane holders on the inner wall of the housing, i.e., individually connecting the membrane holders to the inner wall.

For example in the “X” references cited in the PCT search report, US Patent 4,038,190 discloses only a single membrane holder of “core” defining two or four grooves for accommodating hollow fiber membranes. The membrane holder or core is not connected to the inner wall of the housing or casing.

JP 7-148421 discloses membrane holders, identified as unit filtration elements, sealed together with a beam. Thus, the membrane holders are first fixed together and only then arranged in a housing.

Similarly, in JP 7-124445 a monolithic structure is created by sealing the fan-shaped cartridges or membrane holders to each other and to the housing

In EU 0331067, the membrane holders 9 are held together by caps 12 at their ends. Thus, there is no connection between the membrane holders and the housing.

In JP 58-207904, there is only a single membrane holder defined by a cross-shaped central beam 14 and a net 11, which includes four chambers. The membrane holder is held only at its ends and is not connected to the inner wall of the housing.

As none of the references in the PCT search report anticipate the claimed filter,

the Examiner's reliance on anticipation to justify the Restriction Requirement is improper and the Restriction should be withdrawn.

In the present Office Action, the Examiner alleges that the restriction is proper because "at least US 4,038,190 does anticipate at least claim 1." However, this reasoning is not in keeping with the rules of Unity of Invention, which allow the Examiner to issue a restriction type requirement only if no unity of invention exists. However, the Examiner must state why there is no "single general inventive concept" (see MPEP §1893.03(d)). In the present case, stating that "at least US 4,038,190 does anticipate at least claim 1" fails to indicate why there is no single general inventive concept among the alleged separate inventions.

Further, according to Unity of Invention practice, a single Application may include one invention or more than one invention if the inventions are "linked as to form a single general inventive concept." If multiple inventions are included in the application, they are deemed to be linked if there exists a "technical relationship among the inventions that involve at least one common or corresponding special technical feature." As the Examiner has again failed to demonstrate there is no unity of invention, the Restriction Requirement is improper and must be withdrawn.

### Interview

A telephone interview was conducted on October 6, 2009 between Applicant's representative and Examiner Menon to clarify the components of the applied references that the Examiner believes correspond to the claimed subject matter. The following discussion of the applied art is based on the outstanding Office Action and

the structure identified by the Examiner as allegedly corresponding to the claim elements.

**Claim Rejections Under 35 USC §102**

Claims 1-4, 6, 7, 12 21, 22 and 24 are rejected under 35 USC §102(b) as being anticipated by US Patent 4,038,190 to Baudet et al. (Baudet). The rejection is respectfully traversed.

Independent claim 1 is amended to recite that the membrane holders are arranged on the inner wall of the housing "via at least one coupling device comprising at least one rib, extending in a lengthwise direction and at least one groove extending in the lengthwise direction, wherein the at least one rib is associated with and guided in the at least one groove."

Baudet discloses in Fig. 17, channel shaped cores which can be used for a process of manufacturing a fluid fractionation apparatus. The channels 30, 30' receive hollow fibers 2. It is the channels which form a core 1 that the Examiner alleges correspond to the claimed membrane holders. However, in Baudet the core (channels 30, 30') do not have at least one groove and at least one rib that comprise a coupling device that couple the membrane holders to an inner wall of the housing, as recited in independent claim 1.

For at least the above reasons, Baudet fails to disclose or suggest each and every feature recited in the rejected claims. As such, withdrawal of the rejection is respectfully requested.

Claims 1-4, 6, 7, 12 21, 22 and 24 are rejected under 35 USC §102(b) as being anticipated by US Patent 4,231,879 to Spranger. The rejection is respectfully traversed.

It is alleged in the Office Action that the outer cover plates 3, 4 and the elongated legs 7a, 7b of the end fitting 7 correspond to the claimed housing. As determined during the interview, the Examiner also alleges that the cover plate 4 corresponds to the claimed membrane holder. However, the arrangement of the plates 3, 4 and the legs 7a, 7b of the end plate 7 do not anticipate the claimed membrane holders arranged on the inner wall of the housing "via at least one coupling device comprising at least one rib, extending in a lengthwise direction and at least one groove extending in the lengthwise direction, wherein the at least one rib is associated with and guided in the at least one groove."

Further, Spranger does not disclose or suggest a housing with a first open end and a second open end.

For at least the above reasons, withdrawal of the rejection is respectfully requested.

### **Claim Rejections Under 35 USC §103**

Claims 1-9, 12-18, 21, 22 and 24 are rejected under 35 USC §103(a) as unpatentable over Baudet or Spranger in view of US Patent 3,993,816 (816) and/or US Patent Application Publication 2004/0200768 to Dannenmaier et al. (Dannenmaier). The rejection is respectfully traversed.

The pending claims are not disclosed or suggested by the combination of

references at least because neither Baudet nor Spranger disclose or suggest the features of the independent claims as discussed above.

It is alleged in the Office Action that either Baudet or Spranger disclose all of the features of the rejected claims except for claims 5 and 13-18. In an effort to overcome the deficiencies, it is alleged that the 816 reference discloses the additional features of claims 5, 13 and 14 fails to overcome the deficiencies of Baudet and Spranger. Claims 5, 13 and 14 are allowable for at least their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein.

It is also alleged in the Office Action that Dannenmaier discloses "holders with longitudinal joints that can be disconnected and the holders bend open. Thus, the application of Dannenmaier in rejecting claims 15-18 is unclear as the claims do not recite such a feature.

### **CONCLUSION**

In view of the above remarks and amendments, Applicants respectfully submit that each of the rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Fitzpatrick at the telephone number below.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By

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